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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,918	02/17/2004	Timothy Piumarta	PEAA 314	1906
23581	7590	05/31/2006		
KOLISCH HARTWELL, P.C. 200 PACIFIC BUILDING 520 SW YAMHILL STREET PORTLAND, OR 97204			EXAMINER WATKINS III, WILLIAM P	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/780,918

Applicant(s)

PIUMARTA

Examiner

William P. Watkins III

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1772

DETAILED ACTION

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this

Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-13, 15-20, 22-25 27-35 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stier et al. (U.S. 4,931,330) in view of Emal et al. (U.S. 4,042,739).

Stier et al. teaches a grip tape or sheet with grit joined to a substrate layer and an adhesive and release layer under the substrate layer (abstract, Figure 2). Emal et al. teach the use of perforations on a tape that is to be secured to a substrate in order to allow venting of air through the tape to prevent bubbles from forming when the tape is joined to the substrate (Figure 2, col. 3, lines 5-10). The instant invention claims a grip tape with perforations. It would have been within the ordinary skill of the art to have used perforations in the sheet of Stier et al. in order to allow venting of air when the sheet

Art Unit: 1772

of Stier et al. is secured to a substrate because of the teachings of Emal et al. Selection of hole size and distribution to allow adequate and timely air venting for a given application is taken as being within the ordinary skill of the art absent unexpected results.

3. Claims 2, 14, 21 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stier et al. (U.S. 4,931,330) in view of Emal et al. (U.S. 4,042,739) as applied to claims 1, 3-13, 15-20, 22-25 27-35 and 41 above, and further in view of Wilson et al. (U.S. 5,296,277).

Wilson et al. teaches the use of multiple ply plastic films as tape backings (col. 5, lines 10-20). The instant invention claims a two ply backing layer. It would have been obvious to one of ordinary skill in the art to have used a multiple ply backing in layer in order to have increased strength in the tape sheet of Stier et al. as modified above because of the teachings of Wilson et al.

4. Claims 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stier et al. (U.S. 4,931,330) in view of Emal et al. (U.S. 4,042,739) as applied to claims 1, 3-13, 15-20, 22-

Art Unit: 1772

25 27-35 and 41, and further in view of Slocum et al. (u.s. 5,888,614).

Slocum et al. teaches the use of a pin roller and mating roller to perforate a film structure (abstract, Figure 5a). The instant invention claims the use of a pin roller structure to perforate a grip tape. It would have been obvious to one of ordinary skill in the art to have perforated the tape sheet of Stier et al. as modified above by using a pin roller because of the teaching of Slocum et al. that this is an efficient way to perforate sheet material. Use of a flat needle press would have been obvious from this teaching if a batch operation was desired.

5. Applicant's arguments filed 20 March 2006 have been fully considered but they are not persuasive.

Applicant argues regarding the combination of Stier et al. and Emal, that Stier et al. teaches away from the combination because holes would degrade the performance of the tape in a bath tube, and that Emal provides no teaching to use holes on a grip tape because it is only directed to forming a smooth tape on walls. Regarding the destruction of the purpose of Stier et al. there is no evidence of record that small holes in the mat

Art Unit: 1772

of Stier would cause delamination of the sheet of Stier during ordinary cleaning. This is only applicant's assertion. Stier et al. only discusses delamination with respect to the prior art thick and flexible vinyl patches. Regarding Emal being directed to smooth wall paper, Stier et al. at col. 4, lines 30-40 explicitly notes the problem of air bubbles. One seeking to avoid the chore of careful pressing to remove the air bubbles would certainly look to reference such as Emal that directly addresses this problem. This is an explicit motivation to combine the references.

The declaration of Mr. Denike alleges commercial success, long felt need and copying by others as secondary indicia of nonobviousness. As a first point, Denike states that the Mob Grip has risen to be regarded as the second best selling grip tape in the market. There is no factual basis given as to how Mr. Denike has determined that it is the second best selling grip tape. Also regarding commercial success there are no statements regarding other possible factors that may have influenced sales of the product such as the degree of advertising and replacement of an existing product (MPEP 716.03(b) I.).

Art Unit: 1772

The scope of the instant claims is also much broader than any possible showing of commercial success or long felt need as the tape of the instant claims can be used on any type of surface, not just the skate boards where applicant alleges a showing of secondary indicia (MPEP 716.03(a) I.). It is also unclear if the sales have resulted from a nexus with the instant claims. For one thing there is no description of the actual product being sold that shows that it embodies the claimed invention. Also the survey of customers merely states that they recognize the problem of bubbles and that the tape solves it. It does not state that the product was bought because of the vent holes. The buyers may have been motivated by the appearance of the product or some other selling feature.

Regarding long felt need, it is required that others were aware of the problem for a long period of time and attempted to solve the problem without success (MPEP 716.04). There is only a statement in the declaration that Mr. Denike was aware of the problem for many years and did not see any attempt to solve the problem by other makers of grip tapes. There is no evidence that other makers tried and failed to solve the problem.

Regarding copying there is no evidence that the other tape makers derived their products from applicant's disclosure or

Art Unit: 1772

that they attempted to solve the problem before hand and abandoned their efforts when they were exposed to applicant's product that practices the claimed invention (MPEP 716.06).

Also regarding general credibility, there is no statement of Mr. Denike's financial interest in the instant application or his relationship to the inventors.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William

Art Unit: 1772

P. Watkins III whose telephone number is 571-272-1503. The examiner works an increased flex time schedule, but can normally be reached Monday through Friday, 11:30 A.M. through 8:00 P.M. Eastern Time. The examiner returns all calls within one business day unless an extended absence is noted on his voice mail greeting.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



WW/ww
May 30, 2006

WILLIAM P. WATKINS III
PRIMARY EXAMINER